

III. REMARKS

Claims 1-22 are pending in this application. Claims 5 and 9 are cancelled herein. By this amendment, claims 1, 6, 10, 11, 15, 18 and 22 have been amended. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action claim 1-10 are rejected under 35 USC §101 because the claimed invention is directed to non-statutory subject matter. The Examiner alleges that the first prong of a two prong test is not met by the present invention, namely that "the claimed invention must be within the technological arts." Respectfully, Applicant contends that the "technological arts" test applied by Examiner is incorrect. Excerpts from the USPTO's Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (signed 26Oct2005) explicitly support Applicant's position, namely: "The following tests are not to be applied by examiners in determining whether the claimed invention is patent eligible subject matter: (A) 'not in the technological arts' test (B) Freeman-Walter-Abele test (C) mental step or human step tests (D) the machine implemented test (E) the per se data transformation test." (Emphasis added). Accordingly, Applicant requests withdrawal of the rejection.

In the Office Action, claims 1-4, 6-8, and 11-22 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Machin *et al.* (US. Patent No. 6,877,034). Further, claims 5, 9, and 10 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Machin.

Regarding claim 1, Applicant respectfully requests withdrawal of the rejection because Machin does not teach, or suggest, each and every feature in claim 1, as amended (see also claims 6, 10, 11, 15, 18 and 22). Further, the invention claimed invention is not obvious in view of Machin. Applicant respectfully contends that Machin, in fact, does not teach, or suggest, at least two (2) limitations found in independent claim 1.

Interpreting Machin only for the purposes of this response, Applicant submits that, to the contrary, Machin does not teach or suggest any type of method that includes “**assessing impacts of the solutions on the operational metrics for the industry; after assessing, then comparing a current operational performance of the company**” (emphasis added), as in claim 1 of the present invention. To the contrary, Machin teaches and discloses, via its “gap versus solution optimizer report”, a method that employs a “summary of potential solutions available on the market for narrowing or eliminating that **gap**” (emphasis added). Col. 12, lines 17-21. Clearly, as Figure 14 shows, the suggested solutions and their various impacts (e.g., ROI, GapImpact, risk, etc.) are all in relation to how they may/may not effect the gap in a specific company and *not* first assessing impacts of solution on the metrics **for the industry**, as in the present invention (emphasis added). In fact, Machin is completely devoid of even a suggestion of first assessing the various impacts on operational metrics for an entire industry, as with the present invention, and then making any sort of comparison analysis.

Second, it is not obvious in view of Machin to first assess impacts, and then after assessing, *then* compare, as in the present invention. The Office Action contends (in its review of previous claim 5) “it is old and well known in the art of performance management to assess solutions to improve upon the metrics to determinc the if the solution would benefit or hurt the metric.” (sic) Page 8, item 10. The Office Action continues: “It would have been obvious to one 09/940,974

of ordinary skill in the art at the time of the invention to perform the assessment of the solutions *prior* to comparing against performance of other companies so the company would know which area could benefit most". (emphasis added) Page 9, item 10. Respectfully, Applicant traverses the Examiner's assertion that this is "old and well known" and requests that the Examiner must support the assertion with adequate evidence. See e.g., MPEP 2144.03C. The Examiner's statements appear to merely conclusory, in nature.

Accordingly, Applicants submit that there is no teaching or suggestion in Machin of any type of a method that first assesses the various solutions and their impacts on operational metrics in an entire industry, and then makes various comparisons and identifications regarding a specific company, as disclosed in claim 1, as amended. Therefore, Applicant respectfully requests withdrawal of the rejection of claim 1.

With respect to dependent claims 2-4, Applicant herein incorporates the arguments presented above with respect to the independent claim from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

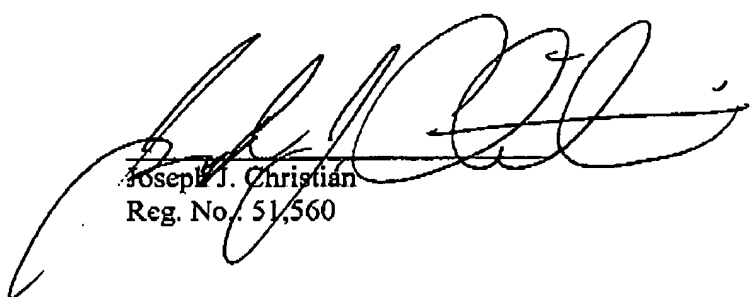
Further, regarding independent claims 6, 10, 11, 15, 18 and 22 and dependent claims 7, 8, 12-14, 16, 17, and 19-21 Applicant contends that for the same reasons stated above, that these claims too are allowable and, accordingly, requests withdrawal of the rejections thereto.

IV. CONCLUSION

In light of the above remarks, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

Date: November 22, 2005



Joseph J. Christian
Reg. No. 51,560

Hoffman, Warnick & D'Alessandro LLC
75 State Street, 14th Floor
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)